

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 1-66 are being cancelled. Claims 67 – 130 are being added as new claims.

This amendment changes, deletes and adds claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 67-130 are now pending in this application.

Prior Art Rejections

Claims 2, 4, 8, 14, 17, 19, 23, 25, 26, 29, 34, 35, 40-43, 46-50, 53, 60, 63 and 66 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,948,040 (“DeLorme”). Claims 44, 45, 51, 52, 58, 59, 61, 62, 64 and 65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DeLorme in view of Official Notice. Claim 57 stands rejected as anticipated by Foreclosure Search.

Other Rejections

Claims 2,4,8,14, 40-46 and 57 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Response And Summary of Interview

In response, Applicant has presented new claims which are distinguished over the art relied upon in the Office Action and are distinguished over new art, cited herein.

Applicant relies on M.P.E.P. § 2131, entitled “Anticipation – Application of 35 U.S.C. § 102(a), (b) and (e)” which states, “a claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Applicant respectfully submits that neither DeLorme nor Foreclosure Search describes each and every element of any of the claims. Applicant further submits that none of the claims is obvious over any of the references alone or in combination with any of the Official Notice factors mentioned in the Office Action. Applicant also makes of record additional art, i.e., U.S. Patent 6,487,538 to Gupta and U.S. Patent 6,757,740 to Parekh,

without admitting that either Gupta '538 or Parekh '470 constitutes prior art or art citable against the present claims.

Applicant wishes to thank the Examiner for courtesies extended to applicant's counsel during an interview held on Dec. 11, 2009. During the interview new claims 67-130 were discussed along with the references cited in the Office Action mailed on Sept. 23, 2009. Also discussed were U.S. Patent 6,487,538 to Gupta, U.S. Patent 6,757,740 to Parekh, cited by the Applicant and provided to the Examiner with the Request For Interview. An Information Disclosure Statement formally making Gupta' 538 and Parekh '740 of record is being submitted with this response.

Claims 1-66 have been cancelled. New claims 67-130 are presented for consideration.

The invention is drawn to a method, system and software for geographically focused network advertising. The application was filed on November 17, 2000, based on a provisional application filed on November 17, 1999. At that time, the Internet was in its relatively early stages of commercialization.

New claims 67-81 recite a computer readable storage medium. As recited in claim 67, the storage medium includes program code that receives at a first information site on a network an information request from a communications device connected through the network. The storage medium also includes program code that determines a geographic area for relevant information to be provided in answering the information request. The storage medium further includes program code that retrieves from a database information that is responsive to the information request and third party information that is not responsive to the information request. The third party information contains a link to connect the communication device to a second information site operated on behalf of the third party. The storage medium also includes program code which is used to provide the answer information to the communication device. New claims 82 – 111 are drawn to a computer server. New claims 112 – 123 are drawn to a method of electronically providing information to a communication device, while new claims 124 – 126 are drawn to a method of providing geographically based third party information to uses of networked terminals. Claim 127 is directed to a method of providing advertisers access to customers based on customers' geographic preferences, the method including providing a web site platform at which customers seek information on topics for geographic locations, and a link to the advertiser

thereon. New claim 128 is directed to a method of advertising which includes receiving a request from a communication device, and answering the request by sending both responsive and non-responsive information to the communication device. New claim 129 is directed to a method of providing advertisers to customers seeking information concerning geographic locations. New claim 130 recites a computer readable storage medium with program code to provide a user information which the user can use to contact a third party. The claims presented all constitute statutory subject matter under 35 U.S.C. § 101.

The present claims are well supported in the specification. For example, the disclosure at page 7, lines 18-28 references a server, geographically based information, database and sponsors, including exclusive sponsors. In addition, a network is disclosed in the specification at least at page 8, lines 4-26 and at p. 9, lines 23-29. A communication device is disclosed in the specification at least at page 5, lines 20-27 and page 8 beginning at line 27. A server is disclosed at page 5 beginning at line 26 and again at page 10 beginning at line 1. The use of geographically based information is disclosed in the specification at least beginning at page 6, line 2-18, page 10 line 1 and page 10 lines 3-13, as well as at other portions of the specification. The fact that information such as advertising can be sponsored or unsponsored is disclosed in the specification at least at page 5, lines 18-19. The use of links is disclosed at least at page 7, line 7. Exclusive sponsorship is disclosed in the specification at least beginning at page 6, line 25.

The present claims are distinguished over U.S. Patent 6,487,538 to Gupta. Gupta discloses a method and apparatus for local advertising (Abstract, l. 1). Gupta discloses developing and maintaining a profile of a user by assembling on-line information, such as the user's age, credit history, earnings, interests, purchases (col. 9, l. 10-27) and off-line information, such as the user's name, residence, phone number, occupation (col. 9, l. 53 - col. 10, l. 1). Gupta then discloses employing the user profile to determine what advertisement to insert into a web page display. (col. 10, l. col. 11, l. 42). Gupta relies on a user profile because Gupta focuses only on the insertion of local advertising into the web page display. Gupta does not disclose determining a geographic area that is relevant to the information request, as recited in the present claims. Even in cases where Gupta appears to consider geographic information, Gupta fails to consider that the information request may concern a geographic area remote from the user's location. For example, at col. 10, l.3 – 5, Gupta discloses that a profile may be limited to a user's recent history, but goes on to say that the

profile would include information about the terminal and the terminal location. Similarly, at col. 10, l. 44 -49, Gupta discloses that the advertiser is interested in people of a certain age group who live in a specific location and who have ordered food on-line. Thus, Gupta is unlike the present invention. In Gupta, the response is based on a user profile, which may or may not include some indication of the user's location. In the present invention, the response is based on the information request, not a user profile. In the present invention, the determination of the geographic area is carried out to determine a geographic area for relevant information to be provided in answering the information request. Gupta does not disclose responding to the information request by determining the geographic area for relevant information to answer the information request. Gupta only discloses providing information based on a user's profile, regardless of the user's geographic preferences.

In actual use, the results of employing Gupta's local advertising would be quite different from the results obtained using the stored program code, apparatus and methods presently claimed. With the present invention, because information to be inserted into the web page is based on the information request, a user in Maryland seeking information about real estate in Phoenix would also be presented advertising for services specific to Phoenix. However, because Gupta inserts information into a web page based on the user's profile and not upon the information request, applying the principles of Gupta's disclosure, the same user in Maryland making the same request for information about Phoenix would see advertising for services in Maryland.

The claims are also distinguished over U.S. Patent 6,757,740 to Parekh. Parekh discloses Systems and methods for Determining Geographic Location and Using Geographic Locations of Internet Users. Unlike Gupta, which relies on a profile, Parekh recognizes that a position targeter can be associated with web sites to target the delivery of information based on the geographic information so that web sites can selectively deliver content of advertising based on the geographic location of its visitors. (col. 3, l. 32-37). However, like Gupta, in Parekh the actual location targeted is not based on the information request, but instead is based on the physical position of the user. Parekh discloses that the method allows the system to determine from which country, state and city the target host originates (col. 6, l. 25-27). Parekh discloses a number of approaches to determining the geographic location of the user with various degrees of confidence. (Col. 4, l. 46, Col. 13, l. 61). However, even where a user elects a different location from the one determined by the Parekh system, that

information is passed back to the position determination system for later analysis. Neither Parekh nor Gupta make any suggestion of determining the geographic area for relevant information from the information request itself, as recited in the present claims. The disclosure in Parekh at col. 16, l. 29-65 provides examples of how the geographic information determined for one user is used to provide information to other users determined to have a similar location or interest. This specifically teaches away from the present invention. In Parekh, the predicted geographic location of the user is the basis for the service provider to determine what advertising to present to the user. In contrast, the present invention looks to the user's information request, either explicit or implicit, to provide the geographic information and allows the advertiser to determine what to present to the user.

The claim rejections made previously over DeLorme and the newly cited Foreclosure Search reference are moot in view of the cancellation of claims 1-66. In any case, the present claims are distinguished over DeLorme and Foreclosure Search.

Foreclosure Search simply illustrates a foreclosure listing site with sponsored advertising. It does not in any way suggest the features recited in the present claims. For example, nothing in Foreclosure Search discloses determining a geographic area for relevant information to be provided in answering an information request and in the answer providing information comprising information responsive to the information request and third party information not responsive to the information request with a link to a site operated on behalf of the third party.

DeLorme discloses an Integrated Routing/Mapping Information System (IRMIS). Although the IRMIS database may be accessed using the internet and other on-line sources (col. 7, l. 3-4), DeLorme discloses a closed system which fails to provide a link to a site operated by a third party as recited in the present claims. One can use DeLorme's online computer aided routing system to input selectable travel origin, destination, and waypoints to compute travel routes, available transportation services, costs, options and schedules. A point of interest database lets users pick types of attractions or accommodations within a user-selected region around routes of travel. (Abstract).

In the Interview summary, the Examiner noted that Fig 9B of DeLorme might be important to consider. Figure 9 illustrates portable TRIPS embodiments. (col. 72, l. 20-21). In Figure 9B, pre-planned travel information is sent to TRIPS provider 904 who transfers the information to Wireless Communication Unit (WCU) 907. (col. 72, l. 50-61). In this

configuration additional “on the spot” information can also be provided to the WCU. (Col. 72, 55-61). Such two-way communications are shown at 903 to facilitate the transmission of TRIPS information packets 939 to the user or vehicle 901, 905, 906. (Col. 73, l. 1-63). Packet 939 includes identification data., topical data, geographic data, temporal data and accounting data (Figure 9B). Unlike the present invention, however, the system disclosed by DeLorme in Fig. 9B is a closed system, which maintains the user within its control (i.e., control of the TRIPS provider) at all times and does not transfer the user to an information site operated by a third party. For example, at Col. 74, l. 20-29, DeLorme discloses that in the later stages of a dialog initiated by a user pushing the RESERVATIONS button, the TRIPS provided (not a third party provider) communicates a specific offer. The fact that the specific offer is for reservations at a facility not operated by the TRIPS provider does not alter the fact that the TRIPS provider maintains complete control over the user and does not link the user in any way to the provider of the service or good requested by the user. All offers are communicated to the user by the TRIPS provider, which is in contrast to the present invention.

DeLorme takes the same approach, retaining user control, during travel planning. Referring to Fig. 5D, DeLorme specifically references Points of Interest (POIs) along a calculated route. However, as disclosed at Col. 28, l. 1 - Col. 29, l. 8, DeLorme provides the user “quick menus” or “listboxes” allowing the user to display further information about POIs without actually being transferred to sites operated on behalf of the POI entities. DeLorme details this distinction over the present claims at Col. 28, l. 55-65, where he discloses that a user can bring up a listbox for tourist attractions and scroll text information concerning the attraction or prompt pictorial and audio information using the Show/Tell function. In making reservations, DeLorme’s Accounting Subsystem “knows” the identities of the participating provider and the registered TRIPS user such that the identity of the party entitled to the reservations is included on the “map ticket” output of DeLorme’s system. Thus, by retaining control of the user and specifically refraining from linking the user to a third party site, DeLorme specifically teaches away from the present claims which all recite providing a link to an information site operated on behalf of a third party.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

Date: Dec. 22, 2009
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5416
Facsimile: (202) 672-5399

By Brian J. McNamara
Brian J. McNamara
Attorney for Applicants
Registration No. 32,789